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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/727,734	11/30/2000	David Naghi	256/280	4195

7590 01/30/2003

STEPHEN C BEUERLE  
PROCOPIO CORY HARGREAVES & SAVITCH  
530 B STREET  
SUITE 2100  
SAN DIEGO, CA 92101

[REDACTED] EXAMINER

LE, KAREN L

ART UNIT	PAPER NUMBER
2642	

DATE MAILED: 01/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/727,734	NAGHI ET AL. <i>(D)</i>
	Examiner Karen Le	Art Unit 2642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 30 November 2000.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-32 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-32 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
     If approved, corrected drawings are required in reply to this Office action.  
 12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
     1. Certified copies of the priority documents have been received.  
     2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
     3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
     \* See the attached detailed Office action for a list of the certified copies not received.  
 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
     a) The translation of the foreign language provisional application has been received.  
 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 .	6) <input type="checkbox"/> Other: _____

## **DETAILED ACTION**

### ***Claim Objections***

In claim 3 “the housing” was not mentioned in claim 2.

In claim 10, the power-consumption should be in mW in stead of mA.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-32 are rejected under 35 U.S.C. 102(e) as being anticipated by DePond et al. (U. S. 6,317,488).

Regarding claims 1, 22 and 23 DePond teaches a call-waiting apparatus (Fig. 1, item 12), comprising: a line connector (Fig. 1, item 50) for connection to an incoming telephone line (Fig. 1, item 49), a phone connector (Fig. 1, item 54) for connection to a telephone handset (Fig. 1, item 40), and a modem/fax connector (Fig. 1, item 52) for connection to a computer modem (Fig. 1, item 56) or fax machine; a controller (Fig. 1, item 20) coupled to the line connector, phone connector, and the modem/fax connector, the controller including an automatic mode (Fig. 1, item 12) in which upon detecting a call-waiting signal from an incoming communication the controller automatically causes a connection between the line connector and the modem/fax connector to be changed to a connection between the line connector and the phone connector (Col. 1, lines 64 –Col. 2, lines 3).

Regarding claims 2 and 24, DePond further teaches the controller further includes a manual mode in which upon detecting a call-waiting signal from an incoming communication, the controller actuates one or more alarms indicating an incoming communication, the manual mode allowing a user to take the communication, causing a connection between the line connector and the modem/fax connector to be changed to a connection between the line connector and the phone connector, or not take the communication wherein the connection between the line connector and the modem/fax connector is maintained (Col. 3, lines 23-35 and Fig. 3, item 88).

Regarding claim 3, DePond further teaches the housing includes a switch for switching between the manual mode (Fig. 3, item 88) and the automatic mode (Fig. 2, item 78).

Regarding claims 4, 15 and 25, DePond further teaches the controller includes a reset timer that prevents a re-connection of the connection between the line connector and the modem/fax connector for at least twenty seconds once the connection between the line connector and the modem/fax connector is changed to a connection between the line connector and the phone connector (Fig. 1, item 38).

Regarding claim 5, DePond further teaches the controller includes one or more integrated circuits (Fig. 1, item 20).

Regarding claim 6 and 26, DePond further teaches the apparatus wherein the one or more integrated circuits includes one or more low power-consumption (Fig. 1, item 35), CMOS-type integrated circuits (Fig. 1, item 20).

Regarding claims 7, 16 and 27, DePond further teaches the apparatus of wherein the connectors (Fig. 1, items 50, 52, 54) are jacks, and the apparatus further includes a case for housing said controller and jacks (Fig. 1, item 12).

Regarding claims 8, 17 and 28, DePond further teaches the apparatus wherein the controller and connectors are part of a circuit board (Fig. 1, item 12).

Regarding claims 9, 18 and 29, DePond further teaches the controller includes a tone decoder with a center frequency of 440 Hz +/- 50 Hz (Col. 2, lines 57-60), and a response time of approximately 10 ms (Fig. 1, item 38).

Regarding claims 10, 19 and 30, DePond further teaches the power-consumption of the apparatus is 15ma or less (Fig. 1, item 35).

Regarding claims 11, 20 and 31, DePond further teaches the apparatus is powered by one or more batteries (Fig. 1, item 35).

Regarding claims 12, 21 and 32, DePond further teaches the apparatus is powered by power from the incoming telephone line (Fig. 1, item 49 and 35).

Regarding claims 13, DePond further teaches the line connector and the modem/fax connector are always connected and the controller causes the connection between the line connector and the modem/fax connector to be superseded by a connection between the line connector and the phone connector upon detecting a call-waiting signal from an incoming communication (Col. 3, lines 3-6).

14. A call-waiting apparatus (Fig. 1, item 12), comprising: a line connector (Fig. 1, item 50) for connection to an incoming telephone line (Fig. 1, item 49), a phone connector (Fig. 1, item 54) for connection to a telephone handset (Fig. 1, item 40), and a modem/fax connector

(Fig. 1, item 52) for connection to a computer modem or fax machine (Fig. 1, item 56); a controller (Fig. 1, item 20) coupled to the line connector, phone connector, and the modem/fax connector, the controller including one or more low power-consumption (Fig. 1, item 35), integrated circuits (Fig. 1, item 20), the controller including a mode in which upon detecting a call-waiting signal from an incoming communication, the controller actuates one or more alarms indicating an incoming communication (Fig. 1, item 24 and 26), the mode allowing a user to take the communication, causing a connection between the line connector and the modem/fax connector to be changed to a connection between the line connector and the phone connector, or not take the communication wherein the connection between the line connector and the modem/fax connector is maintained (Fig. 1, item 36 and 38).

*Conclusion*

6. Any response to this action should be mailed to:

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Or faxed to:

Hand-delivered responses should be brought to  
Crystal Park II, Sixth Floor (Receptionist)  
2121 Crystal Drive  
Arlington, VA 22202

Art Unit: 2642

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen Le whose telephone number is 703-308-4998. The examiner can normally be reached on Monday - Friday from 8:30 A.M. to 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on (703) 305-4731. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4750.

Karen Le  
KLL  
January 24, 2003



AHMAD MATAR  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600